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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,172

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Rainer Uecker

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SIEMENS CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
170 WOOD AVENUE SOUTH  
ISELIN, NJ 08830

EXAMINER

FAN, HUA

ART UNIT

PAPER NUMBER

2152

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,172	<b>Applicant(s)</b> UECKER, RAINER	
	<b>Examiner</b> HUA FAN	<b>Art Unit</b> 2152	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16, 21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16, 21, and 23-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This office action is in response to the Amendments/Remarks filed on 6/6/2008. Claims 16, 21, 23-30 are pending. Claims 1-15 were previously cancelled. Claims 17-20 and 22 have been cancelled. Claims 16 and 28-30 have been amended. No new claims were added.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 16 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 16 and 28 have the limitations of "...indicates that a message to be relayed is...or in a second mail processing device", which was not supported in the originally filed specification.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 16, 21, and 24-30 are rejected under 35 U.S.C. 103(a) as unpatentable over Etsuo (WO 01/20855) in view of Quine (US patent 6988129).

As to claim 16, Etsuo discloses a method for transmitting messages (figure 1 and 2, “mail”) in a network (figure 1 and 2, component 100) via data terminals connected thereto (figure 1 and 2, components 200A, 200B, 200C, 200D, 300), comprising:

    sending a message to be relayed (abstract; page 9, paragraph 4) from a sender data terminal (figure 1 and 2, component 200B) to a first mail processing device assigned to the sender data terminal (figure 1 and 2, component 300);

    assigning a unique identifier to the message) that indicates that a message to be relayed is on the sender data terminal (figure 9 and 5(a), “Identifier”, “Sender Address”; page 21, paragraph 2-3, “PA”, “pair of body and identifier...forwarded body and an identifier”), in the first mail processing device, or in a second mail processing device assigned to a recipient address data terminal, wherein the identifier comprises a plurality of sub-identifiers, each of which is assigned to at least one message element contained in a relayed message (page 21, paragraph 2-3, “pair of body and identifier...forwarded body and identifier”).

    evaluating in the second mail processing device the identifier sent by the first mail processing device, the evaluating configured to process each sub-identifier relative to data present in the second mail processing device indicative of respective message elements previously relayed to the recipient address data terminal (abstract; page 9, paragraph 4 – page 10, paragraph 1);

evaluation result includes transmitting message elements, evaluated as not previously relayed to the recipient address data terminal; and blocking message elements evaluated as

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previously relayed to the recipient address data terminal (abstract; page 9, paragraph 4 – page 10, paragraph 1).

Transmitting or blocking a transmission of respective ones of the message elements to the second mailing processing device in response to the evaluation result (abstract; page 9, paragraph 4 – page 10, paragraph 1);

Relaying to the recipient address data terminal respective message elements transmitted from the first mail processing device to the second mail processing device (page 10, paragraph 1, “sends a receipt notice to the addressee”; page 7, paragraph 3, client accesses to mail server upon receiving the notice).

However, Etsuo does not disclose sending a test message including the subidentifiers from the first mail processing device to the second mail processing device; and sending an evaluation-result message from the second mail processing device to the first mail processing device. Quine discloses sending out a test message to confirm that the new address is correct before sending out notification emails, i.e., whether or not sending out the notification email is based upon the evaluation result of whether the new address is correct or not (col. 7, lines 36-48).

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to combine the teachings disclosed by Etsue with the teachings disclosed by Quine regarding sending out a test message to confirm that the new address is correct before sending out notification emails, i.e., whether or not sending out the notification email is based upon the evaluation result of whether the new address is correct or not. The suggestion/motivation of the combination would have been to make sure the new address is correct (Quine, col. 7, lines 43-48).

As to claim 21, Etsue-Quine discloses the method according to claim 17, wherein the identifier is evaluated on a mail server in the network (Etsue, page 10, paragraph 1; figure 1).

As to claim 24, Etsue-Quine discloses the method according to claim 17, wherein the identifier and/or the relevant subidentifier indicates an e-mail address of an original sender if this differs from the e-mail address of the sender, and/or the contents of the message or of the respective message element (Etsue, page 33, paragraph 4).

As to claim 25, Etsue-Quine discloses the method according to claim 17, wherein there is a data terminal for executing the method (Etsue, claims 1-2 and 7) and having a mail processing device that is designed such that an identifier for a message based on data present concerning the entry of messages at an address data terminal from the past is evaluated in an evaluation unit (Etsue, claims 1-2 and 7), and such that, based on the evaluation result, transmission of a message to the address data terminal is triggered or blocked (Etsue, claims 1-2 and 7).

As to claim 26, Etsue-Quine discloses the method according to claim 25, wherein the mail-processing device forms part of a mail server (Etsue, claim 1), which is integrated in the data terminal (Etsue, mail server can be used as data terminal as well since it is able to generating and receiving emails, page 22, paragraph 4).

As to claim 27, Etsue-Quine discloses the method according to claim 25, wherein a memory unit for storing data concerning the entry of messages at a different data terminal (Etsue, mail server 300, page 22, paragraph 4 – page 23, paragraph 1).

Claim 28 is a network claim corresponding to the method claim 1. Therefore it has been analyzed and rejected based upon the method claim.

As to claim 29, see similar rejection to claim 26.

As to claim 30, Etsue-Quine discloses the network according to claim 29, further comprising a memory unit for storing previously relayed message elements (Etsue, page 35, paragraph 4, “control unit 301 holds forwarding body BO of forwarding e-mail MAILab in the memory unit 303”).

5. Claim 23 is rejected under 35 U.S.C. 103(a) as unpatentable over Etsuo, in view of Quine, as applied to claim 16, and further in view of Yoshihiro (JP 11232188).

As to claim 23, Etsuo-Quine does not expressly disclose a notification of the blocked transmission is forwarded to the sender and/or recipient if the transmission is blocked on the basis of the evaluation result. Yoshihiro discloses a duplicate notice mail is transmitted to the originator of the received electronic mail when it blocks the transmission of the email (abstract).

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to combine the method disclosed by Etsuo-Quine with the method disclosed by Yoshihiro regarding a duplicate notice mail is transmitted to the originator of the received electronic mail when it blocks the transmission of the email. The suggestion/motivation of the combination would have been to inform the originator that the predetermined title and predetermined message of the received E-mail are the same (Yoshihiro, [0020]).

### ***Response to Arguments***

6. Applicant's arguments with respect to amended claims 16 and 28 on page 7 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUA FAN whose telephone number is (571)270-5311. The examiner can normally be reached on M-F 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. F./  
Examiner, Art Unit 2152

/Bunjob Jaroenchonwanit/  
Supervisory Patent Examiner, Art Unit 2152